

Amendment and Response under 37 C.F.R. 1.116

Applicant: Robert Sesek

Serial No.: 09/887,833

Filed: June 21, 2001

Docket No.: 10006174-1 (H303.202.101)

Title: ELECTRONIC DOCUMENT SENDER SYSTEM AND METHOD WITH EXTERNAL ADDRESS ACCESS

REMARKS

The following remarks are made in response to the Final Office Action mailed December 2, 2004. Claim 2 has been cancelled. Claims 1-7, 9-15, 18, 19, and 23-25 were rejected. With this Response, claims 1, 4, 18, and 23 have been amended. Claims 1-7, 9-15, 18, 19, and 23-25 remain pending in the application and are presented for reconsideration and allowance.

Claim Rejections under 35 U.S.C. § 103

In the Office Action, claims 1-7, 9, 10, 12, 13, 15, 18, 19, and 23-25 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Murphy U.S. Publication 2002/0033961 (herein "Murphy").

Independent claim 1 specifies a method of electronic document sending. The method comprises sending an electronic document from an electronic document sender to an electronic document receiver having an electronic address, and electronically obtaining the electronic address of the electronic document receiver, via wireless communication, from an address book located externally of the electronic document sender. Further, obtaining the electronic address includes disposing the address book in a mobile computing device that is separate from the electronic document sender.

Murphy fails to teach or suggest obtaining an electronic address of an electronic document receiver from an address book located externally of the electronic document sender, as claimed by Applicant. Murphy discloses a method of securely sending documents over a network including transforming documents of a first protocol to another protocol for delivery. The cited paragraph 29 on page 3 of Murphy merely discloses that an image data stream is directly transmitted to an IP address corresponding to a reception device. The passage does not disclose or suggest transmission of the address itself. Moreover, reference numeral 32 in Figure 3 refers to an "address book containing subscribers public encryption keys" (Emphasis added; see also page 4, paragraph 57) rather than containing an electronic address of the electronic document receiver as recited in amended, independent claim 1.

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Even if the book of Murphy were to actually include addresses, there is no indication that such addresses are for the electronic reception device described in claim 1. Rather, the addresses, if any, contained in the book of Murphy more likely describe the particular location in the server where the corresponding encryption key is located. This interpretation is bolstered by the specification passages describing how an address of the reception device is manually entered for transmission with a keyboard, keypad, or other mechanisms (See Murphy page 4, paragraph 60; page 5, paragraphs 67 and 71; page 7, paragraph 120) independent of the address book of encryption keys 32. Therefore, Murphy fails to teach or otherwise suggest obtaining an electronic address of an electronic document receiver from an address book located externally of the electronic document sender.

Murphy fails to teach or suggest disposing the address book in a mobile computing device separate from the electronic document sender, as claimed by Applicant. The cellular telephone communication device disclosed on page 7, paragraph 106 is described as being included on a card configured to interface with a PCMCIA card slot 206 of the computer system. The purpose of the card is not disclosed or suggested, and consequently, is not suggested to be used to store recipient addresses. With this in mind, Murphy does not teach or suggest disposing the address book in the cellular device and no other mobile devices are disclosed as communicating with the document sender. In addition, the card, and therefore the components on the card such as the cellular device, are directly coupled to the computer system via the PCMCIA card slot and do not communicate with the system wirelessly, as recited in amended claim 1. Therefore, even if the cellular device did include addresses, which Applicant asserts it does not, the cellular device would not truly be “external” and any address on the device would not be communicated wirelessly as required in other limitations of amended, claim 1.

On page 5, paragraph 71 of Murphy, additional reference is made to retrieving an IP e-mail address “remotely from the flash eeprom or remote data base,” which once again is independent the address book 32. Furthermore, the flash EPROM is described in paragraph 66 of Murphy as being EPROM 68 or EPROM 70. Both EPROM 68 and EPROM 70 are internal parts of the relatively large and stationary ecom 16 that is directly wired to the fax or other document sender (See Figure 9). Accordingly, the EPROM are not “mobile” and, conversely, are coupled to the fax machine with wires, thereby teaching away from wireless

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communication between an external mobile device and the electronic document sender as recited elsewhere in independent claim 1.

For at least the above described reasons, the address book of Murphy is not included on a mobile device or configured for wireless communication. As such, Murphy fails to teach or otherwise suggest disposing the address book in a mobile computing device separate from the electronic document sender.

Murphy fails to teach, suggest, or otherwise make obvious importing the addresses using a wireless communication technique, as claimed by Applicant. The Examiner admits that "Murphy fails to explicitly describe importing the addresses using a wireless communication technique" (Final Office Action, page 5). No suggestion exists within Murphy or within common knowledge within the art to make obvious the wireless communication of addresses to the electronic document sender. In particular, the Murphy passage on page 3, paragraph 38 cited by the Examiner refers to implementing the process already described in Murphy, namely the transmission of facsimile data between two electronic devices over the network, over land lines as well as wireless network architectures. Otherwise stated, although Murphy may suggest transmission of facsimile data between two remotely located fax or other machines over a wireless network, the passage does not apply to importing addresses from a mobile, external device since such importing is nowhere described or suggested by Murphy.

In addition, the Examiner cited passage of Murphy, page 2, paragraph 25 further supports this analysis as the cited passage relates to a electronic device coupled to other fax machines, scanners, etc to communicate over internet networks. Accordingly, this passage also refers to the communication of general facsimile data between reception/sending devices and does not relate to or suggest transfer of address information wirelessly or otherwise to the document sender as recited in amended, independent claim 1. Accordingly, Murphy fails to teach or otherwise suggest using wireless communication to import an address of an electronic document receiver from an address book external of the document sender. Moreover, it would not be obvious to one of ordinary skill in the art to apply the teachings of Murphy to arrive at the wireless importing of reception device addresses prior to reading the Applicant's current disclosure.

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For these reasons, Murphy fails to disclose or otherwise make obvious independent claim 1, and therefore independent claim 1 is believed to be allowable. Based on their dependency from independent claim 1, dependent claims 3- 6 are believed to be allowable as well.

Independent claim 7 specifies a method of document sending. The method comprises electronically importing an electronic address of an electronic document receiver, via wireless communication, from a mobile computing device into an electronic document sender, and sending an electronic document from the electronic document sender to the electronic document receiver using the electronic address.

Independent claim 7 is believed to be allowable for substantially the same reasons explained for the patentability of amended, independent claim 1 over Murphy. For these reasons, Murphy fails to anticipate or make obvious independent claim 7, and therefore independent claim 7 is believed to be allowable. Based on their dependency from independent claim 7, dependent claims 9-11 are believed to be allowable as well.

Independent claim 12 specifies an electronic document sender comprising an imaging mechanism configured for creating an electronic document from a paper document, a user interface, and a communication module. The user interface is configured for activating the imaging mechanism, configured for requesting an electronic address of an electronic document receiver from a mobile computing device that is external to and separate from the electronic document sender, and configured for initiating sending the electronic document to the electronic document receiver. The communication module is configured for wirelessly obtaining the electronic address from the separate mobile computing device and configured for sending the electronic document to the electronic address of the electronic document receiver.

Independent claim 12 is believed to be allowable for substantially the same reasons explained for the patentability of independent claims 1 and 7 over Murphy. For these reasons, Murphy fails to anticipate or make obvious independent claim 12, and therefore independent claim 12 is believed to be allowable. Based on their dependency from independent claim 12, dependent claims 13-14 and 18 are believed to be allowable as well.

Independent claim 15 specifies an electronic document sending system comprising an electronic document receiver having an electronic address, a mobile computing device having

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an external address book with the electronic address of the electronic document receiver, and an electronic document sender. The electronic document sender is independent of the mobile computing device and is configured for sending an electronic document to the electronic address of the electronic document receiver and for obtaining, via electronic wireless communication, the electronic address from the address book of the mobile computing device.

Independent claim 15 is believed to be allowable for substantially the same reasons explained for the patentability of independent claims 1, 7, and 12 over Murphy, since Murphy fails to disclose an electronic document sending system including an electronic document sender configured to obtain, via electronic wireless communication, the electronic address of an electronic document receiver from an address book of a mobile computing device. For these reasons, Murphy fails to anticipate or make obvious independent claim 15, and therefore independent claim 15 is believed to be allowable.

Independent claim 19 specifies a mobile computing device comprising at least one of a portable computer, personal digital assistant, and a mobile phone, each of which includes an address book and a wireless communication module. The address book is configured to store at least one electronic address of an electronic document receiver. The wireless communication module is configured for transmitting the at least one electronic address from the mobile computing device to an electronic document sender that is separate from the mobile computing device.

For the substantially the same reasons explained for the patentability of claims 1, 7, 12, and 15 over Murphy, Applicant submits that Murphy fails to disclose any such mobile computing device separate from an electronic document sender configured to perform the specified functions, as claimed in Applicant's independent claim 19. Therefore, independent claim 19 is believed to be allowable.

Amended independent claim 23 specifies a computer-readable medium having computer-executable instructions for performing a method of document sending, the method being similar to that described in independent claim 7. Therefore, independent claim 23 is believed to be allowable on substantially the same basis explained for the patentability of independent claims 1, 7, 12, 15, and 19. For these reasons, Murphy fails to anticipate or make obvious independent claim 23, and therefore independent claim 23 is believed to be

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allowable. Based on their dependency from independent claim 23, dependent claims 24 and 25 are believed to be allowable as well.

The Examiner rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Murphy in view of Hattori et al. (U.S. Patent No. 6, 512,599). Claim 11 depends from independent claim 7 and additionally recites erasing the imported electronics address after transmission of the electronic document from the electronic document sender, from at least one of an activity log and an internal address book of the electronic document sender.

Dependent claim 11 is believed to be allowable based upon its dependency from independent claim 7. In other words, dependent claim 11 is believed to be allowable over Murphy based upon substantially the same reasons previously explained regarding the patentability of claim 7 over Murphy. The teachings of Hattori do not remedy the deficiencies of Murphy to teach or otherwise suggest the limitations of claim 7 discussed above. With this in mind, Murphy and/or Hattori fail to make obvious the limitations of claim 11. For at least these reasons, dependent claim 11 is believed to be allowable.

The Examiner rejected claim 14 under 35 U.S.C § 103(a) as being unpatentable over Murphy in view of Besprosvan (U.S. Application Publication 2002/0124057). Dependent claim 14 specifies that the user interface of the electronic document sender of claim 12 is configured to request, from the mobile computing device, a distribution list comprising a plurality of electronic addresses of electronic document receivers and the communication module is configured to obtain the distribution list of electronic addresses and send the electronic document to each electronic address in the distribution list

First, dependent claim 14 is believed to be allowable based upon its dependency from independent claim 12. In other words, dependent claim 14 is believed to be allowable over Murphy based upon substantially the same reasons previously explained regarding the patentability of claim 12 over Murphy. Besprosvan also fails to cure the deficiencies of Murphy. For these reasons, Murphy and/or Besprosvan, alone or in combination, fail to make obvious dependent claim 14, and therefore, dependent claim 14 is believed to be allowable

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Other Amendments

Dependent claim 4 was amended merely to correct dependency necessitated by the canceling of claim 2. Dependent claim 18 was amended merely to correct a typographical error. As such, these claims were not amended for any reason related to patentability.

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-7, 9-15, 18-19, and 23-25 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-7, 9-15, 18-19, and 23-25 is respectfully requested.

No fees are required under 37 C.F.R. 1.16(b)(c). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 08-2025.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 2nd day of February, 2005.

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